

Oral Hearing:

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9/22/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Automotive Technologies, Inc.**

Serial No. 75/**369,329**

Wm. Tucker Griffith and Theodore R. Paulding of McCormick,
Paulding & Huber, LLP for **Automotive Technologies, Inc.**

Katherine Bush and Lisa Rosaya, Trademark Examining
Attorneys,¹ Law Office 112 (**Janice O'Lear**, Managing Attorney).

Before **Hohein, Walters and Bottorff**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Automotive Technologies, Inc. has filed an
application to register the mark "SKYWAVE PRODUCTS" and
design, as reproduced below,

¹ While the former (hereinafter referred to as the Examining
Attorney) issued the final refusal in this case and submitted the
brief, the latter presented the oral argument.

for the following goods:²

"wireless telephone accessories, namely, antennas, batteries, battery base plates, battery chargers and savers, cables, car speakers, cases, cords, cradles, mounts, holders, modems, transformers, microphones, amplifiers, speakers, connectors, and data interfaces comprised of cables and adapters, global positioning satellite tracking receivers and displays, automotive navigational systems comprised of global positioning satellite receivers, display units and processors, wireless pagers, and power cords; computer accessories, namely, modems, PCMCIA cards, cases, cords, pointing devices, and printers; [and] computer software, namely, for electronic mail, for accessing global information networks, for use in database management, [and] for use in telecommunications management.

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the words "SKYWAVE PRODUCTS," which the Examining Attorney maintains are merely descriptive of

² Ser. No. 75/369,329, filed on October 7, 1997, which alleges dates of first use of April 12, 1996. The word "PRODUCTS" is disclaimed and the stippling is for shading purposes only.

applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).³

Applicant has appealed. Briefs have been filed⁴ and an oral hearing was held. We reverse the refusal to register.

It is essentially the Examining Attorney's position that because sky waves are a kind of radio waves, which in turn are utilized by wireless communications devices, the

³ While the Examining Attorney, among other things, states in her final refusal that the words "SKYWAVE PRODUCTS" merely describe applicant's goods inasmuch as "one significant function of the applicant's goods is that they utilize and work in conjunction with a particular form of wireless communication, namely that which is based on *skywaves*," she also states, in the alternative, that:

If, however, the applicant's goods do NOT utilize skywaves, the mark would be misdescriptive of the applicant's goods. In either case, the applicant must disclaim all of the wording of the mark[.]"

⁴ Although applicant, in its initial brief, argues that the words "SKYWAVE PRODUCTS" are neither merely descriptive nor deceptively misdescriptive of its goods, the Examining Attorney in her brief contends that the sole issue on this appeal is "[w]hether the phrase 'skywave' in the applicant's proposed mark SKYWAVE PRODUCTS (and design) is descriptive of applicant's goods, namely wireless telephone related products, and therefore a disclaimer of 'skywave products' is proper" In particular, the Examining Attorney insists that:

The applicant has included arguments that the phrase "skywave products" is not deceptively misdescriptive of the goods; however, the examining attorney has not issued a disclaimer requirement based on misdescriptiveness. Therefore, the examining attorney does not respond herein to these arguments.

In view thereof, to the extent that the final refusal alternatively was based on the ground that a disclaimer was required because the words "SKYWAVE PRODUCTS," when used in connection with applicant's goods, are deceptively misdescriptive thereof, we consider such basis to be withdrawn.

words "SKYWAVE PRODUCTS" are merely descriptive of applicant's goods and must be disclaimed in order for applicant's mark to be registrable. Specifically, according to the Examining Attorney:

Sky waves are a component or [sic] radio waves, as defined in *Prentice Hall's Illustrated Dictionary of Computing*, previously made of record by the applicant:

Radio Wave Propagation:

When radio waves are radiated, there are usually two components: the 'ground' wave, which is propagated direct from the transmitting aerial to the receiving aerial in a straight line; and the 'sky' wave, which is propagated upward over a wide range of angles until it meets an ionized layer high above the Earth's surface.

It is common knowledge that wireless communication devices utilize radio waves to transmit data from one location to another. In fact, the applicant made of record a copy of a web site from "WOW-COM The World of Wireless Communication" that reads as follows:

How does wireless technology work?

Wireless communications systems provide anytime, anywhere communications. **When you talk on a wireless phone, it transmits low energy radio waves to a local antenna site, which connects you with the landline or wireless location you are calling.** That same antenna also sends signals back to your wireless phone...

As explained above, *sky waves* are, in fact, *radio waves*. Wireless technology utilizes radio waves, including *sky waves*.

In view thereof, and since many of applicant's goods, including its antennas, modems and wireless pagers, "*directly* utilize radio waves, or '*sky waves*,' " the Examining Attorney insists that:

It is clear that the phrase "*skywave products*," as applied to the goods, immediately conveys to potential purchasers that the goods utilize a component of radio waves called *sky waves*. Further, the term "*products*" lacks any trademark significance as applied to the goods. Therefore, a disclaimer of the phrase "*skywave products*" is proper.

Likewise, because "many other goods identified by the applicant are accessories for sky wave products, such as applicant's batteries, battery chargers and savers, the Examining Attorney concludes that the words "SKYWAVE PRODUCTS" immediately describe a function, feature, purpose or use of those goods and thus "a disclaimer of the phrase '*skywave products*' is proper."

Applicant, on the other hand, argues that the Examining Attorney is in error in asserting that any of its goods utilize sky waves or are accessories for use with products which use sky waves. In particular, while applicant concedes in its initial brief that "wireless communications rely upon radio frequencies" and "does not dispute the

Examining Attorney's definitions of 'sky wave' and 'radio wave propagation,'"⁵ applicant correctly "notes that while a sky wave is a form of radio wave propagation, all radio wave propagation does not necessarily make use of sky waves--e.g., ground waves, space (tropospheric) waves, and satellite transmissions are viable means of wireless communication." Applicant consequently "strongly disagrees with the Examining Attorney's assertions that the wireless communications devices with which Applicant's goods may be used necessarily make use of sky waves." To the contrary, applicant categorically states that: "None of Applicant's goods make direct use of sky waves."

Specifically, as explained in its initial brief, applicant further points out that:

For ease of analysis, Applicant's goods will be divided into the following groupings: Wireless telephone accessories; GPS [("global positioning system")] accessories and wireless pagers; and portable computer accessories (including computer software).

⁵ We judicially notice in this respect that, as stated in applicant's reply brief, the term "sky wave" is defined in The Computer Glossary (8th ed. 1998) as "[a] radio signal transmitted into the sky and reflected back down to earth from the ionosphere." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Wireless telephone accessories, as sold by Applicant under the trademark "SKYWAVE PRODUCTS and Design", do not include wireless telephones themselves. Rather, they are "accessories", intended to be used with wireless telephones of any kind, brand, or model. None of the accessories make any use of sky wave technology.

....

GPS systems, by definition, do not make use of sky waves. Instead, signals are transmitted to and from satellites, and there is no need to bounce radio waves off the ionosphere (as is done with sky waves), especially with the risk of a significant percentage of the waves being lost, when the waves can be transmitted via satellite technology.

As with wireless telephone accessories, none of these GPS accessories make any use of sky waves. Wireless pagers are similar to GPS systems in that they rely on satellite technology for operation. Accordingly, it is improper to refuse registration of the mark with respect to these goods on the basis that it is merely descriptive.

The same arguments articulated above are applicable to computer accessories and computer software. Sky waves are simply unnecessary for their operation.

We observe, however, that in fairness, applicant acknowledges in its initial brief that:

The Examining Attorney's position would have been the strongest for communication devices ... which Applicant has deleted from its list of goods via Amendment (i.e., telephones, two-way radios). "SKYWAVE PRODUCTS and Design" does make reference to a technology upon

which wireless communication may be based. However, for the same reasons articulated above, a refusal of "SKYWAVE PRODUCTS and Design" even for some communications devices based on descriptiveness is still improper. Some modern cellular telephones are similar to GPS systems and wireless pagers in that they rely heavily on satellite technology for operation. Other cellular telephones do not need long distance wave propagation (which sky waves provide) because the signal is transmitted from the telephone to a cell through direct waves over a relatively short distance and then into conventional phone lines. Two-way radios, such as "walkie-talkies[,]" only transmit radio waves over short distances, and therefore, rely upon ground wave technology.

Applicant consequently concludes in its initial brief that:

The Examining Attorney's reliance on cases which state that a term is descriptive if it describes one attribute of the goods is improper in situations where no attributes of the goods can be described by the goods [sic]. That is the situation here. If there is any connotative connection between the term "sky wave" and the telecommunications accessories listed above, it is because there is a suggestive nature to the applied-for mark. The crux of Applicant's argument ... is that Applicant's goods can function without the use of sky waves, and indeed rely on technology separate from radio wave propagation in order to function. Other goods rely on satellite technology--e.g., GPS products--or telephone lines--e.g., modems. Even goods that require radio waves function merely by use of ground wave (or direct wave technology whereby the signal is sent from the transmitter directly to the receiver.

Thus, to say that wireless telephone accessories "utilize" wireless communication is a severe stretch.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from

consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

In the present case, it is plain from both applicant's arguments and the technical information of record that neither GPS systems, such as global positioning satellite tracking receivers and displays, automotive navigational systems consisting of global positioning satellite receivers,

display units and processors, and wireless pagers, nor computer accessories, including, modems, PCMCIA cards, pointing devices and printers, utilize sky waves in any manner. The same is likewise true for computer software, including that for use with electronic mail, accessing global information networks, database management, and telecommunications management. The Examining Attorney, furthermore, does not appear to contend otherwise. Nevertheless, registration must still be denied if a mark is merely descriptive of any of the goods or services for which registration is sought, which in this case leaves us with consideration of applicant's various wireless telephone accessories. Clearly, and contrary to applicant's assertions, if its mark is merely descriptive of wireless telephones, the mark would also be merely descriptive of accessories therefor.

On the present record, however, we find the Examining Attorney's position that the term "SKYWAVE PRODUCTS" is merely descriptive of applicant's wireless telephone accessories, and therefore must be disclaimed, to be too tenuous and speculative. To reiterate, applicant has categorically stated that "[n]one of Applicant's goods make direct use of sky waves." More importantly, it does not appear from the limited evidence in this record that either wireless telephone accessories of the kinds identified in the

application, including antennas, modems and amplifiers, or wireless telephones, such as cellular telephones, operate with or utilize radio waves of the wavelength or frequency known as sky waves. While applicant does acknowledge that wireless communication may be based upon the use of sky waves, the record in this case shows that it is radio station broadcasting services and the transmission equipment associated therewith, rather than wireless telephone communication services and the mobile telephones used therefor, which need to rely upon sky waves in order to achieve long distance signal propagation.⁶

⁶ The following excerpts from articles retrieved by the Examining Attorney's search of the "NEXIS" database are representative (**emphasis added**):

"Among FCC proposals on improving AM ... were those to: (1) Revoke permits of stations off air for 'substantial period of time'. (2) Develop new **skywave** and groundwave curves to predict interference more accurately." -- Communications Daily, June 22, 1990;

"AM **skywave** field strength. Proposed improved methods for calculating **skywave** field strength in the AM broadcast band. Comments due Dec. 27, replies Jan. 11." - Electronic Media, November 14, 1988;

"Plan is to operate station for about 2 years to test prototype antennas designed to achieve separate control over **skywave** and groundwave signals. If new antennas prove successful, NAB will urge AM stations to adopt them and FCC to incorporate their parameters in rules." -- Communications Daily, June 9, 1988; and

"[A]doption of the NRSC Voluntary Standard as mandatory is essential, as is selection of a single AM stereo standard; and abolition of protection to the

We are thus constrained to agree with applicant, as persuasively argued in its reply brief, that (**emphasis in original**):

Certainly, wireless technology utilizes radio waves. Also, Applicant acknowledges that sky waves are indeed radio waves. However, it is equally clear that not all radio waves are sky waves, and accordingly, not all wireless devices utilize sky waves for operation.

The Examining Attorney appears to be arguing that "radio wave" and "sky wave" are synonymous. However, the Examining Attorney herself, in an effort to argue the descriptiveness of the Applicant's mark, acknowledges that wireless technology, and in particular cellular communications, successfully operates without reliance on sky waves. For example, the Examining Attorney cites the web site "WOW-COM The World of Wireless Communication" and emphasizes the following passage regarding how wireless technology works: "[w]hen you talk on a wireless phone, it transmits low energy radio waves to a local antenna site, which connects you with the landline or wireless location you are calling. Referring to *Prentice Hall's Illustrated Dictionary of Computing* which the Examining Attorney also cites in her brief, it is abundantly clear that wireless technology relies on ground waves, "which [are] propagated direct **from the transmitting aerial to the receiving aerial in a straight line**". In short, the telephone (the transmitting aerial) sends a signal via **a ground wave** to a cellular

secondary **skywave** service areas of clear-channel stations is clearly called for.

Local service, not distant service, is what radio is all about." -- Electronic Media, February 1, 1988.

antenna (the receiving antenna) which patches the call into the landline or transmits the signal to another telephone directly if that telephone is in the same cell. The ionosphere does not come into play at all during this type of transmission, and thus, cellular transmissions are completed without sky waves. Thus, it is clear that traditional cellular communication, as described by WOW-COM, in light of the *Dictionary of Computing*, makes no use of sky waves for successful operation whatsoever.

Indeed, there are cellular antennas all over the place and thus, numerous "cells" within a relatively small geographical area. If cellular communications relied upon sky waves, there wouldn't need to be as many cellular antennas, since the purpose of the sky wave is to transmit signals which may be received over large geographical areas. Simply stated, sky waves are for long distance radio wave propagation, such as for radio station broadcasts, as is evidenced by the numerous articles from the Nexis Research Database produced by the Examining Attorney.

Moreover, the trend of the cellular community is towards digital technology, with which traditional radio wave propagation is bypassed for the use of satellites. By definition, a [radio] wave transmitted to and from a satellite cannot be a sky wave. As is undisputed, a sky wave is "a radio signal transmitted into the sky and reflected back down to earth from the ionosphere". Accordingly, any cellular telephones which rely upon satellites, but which still utilized sky waves, would never complete a phone call because the sky waves would bounce off the ionosphere before reaching the satellites, which traditionally orbit around the earth well above the ionosphere.

The present record, consequently, fails to show that wireless telephones and their accessories, such as antennas, modems and amplifiers, have any function, feature, purpose or other aspect which utilizes sky waves, as opposed to other types of radio waves, in their operation so as "to transmit data from one location to another" as contended by the Examining Attorney. The Examining Attorney's position that applicant's goods are "sky wave products" rests on assumptions which have no demonstrable basis in fact and which, as pointed out by applicant, are contrary to the emerging trend towards digital satellite communications, which do not and in fact could not operate through the use of sky waves. The evidence, in summary, is simply insufficient to show that wireless telephones and their accessory products have any characteristic, feature or function which would utilize or operate in conjunction with sky waves as the technological means for transmitting and receiving communications signals. A refusal on the ground of mere descriptiveness cannot properly be based on some theoretical or otherwise speculative possibility.

We find, therefore, that the while the terminology "SKYWAVE PRODUCTS" is suggestive of the radio-based technology utilized by wireless telephone equipment, it requires imagination or a multi-stage reasoning process in order for

customers or prospective purchasers of accessories for wireless telephones to conclude, as urged by the Examining Attorney, that such goods are or would be products based upon sky wave communications technology. The term "SKYWAVE PRODUCTS," when used in connection with the wireless telephone accessories identified in applicant's application has not been shown on this record to immediately or directly describe any significant aspect of either applicant's particular goods or goods of such type in general. A disclaimer of such term is therefore not required. However, to the extent that there may be any doubt with respect to whether sky waves lend themselves to use with wireless telephones, as opposed to radio station broadcasting applications, and thus there may be some doubt as to whether the term "SKYWAVE PRODUCTS" in applicant's mark is merely descriptive rather than suggestive of its various accessories for wireless telephones, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. See, e.g., In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981) and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal under Section 6(a) is reversed.

G. D. Hohein

C. E. Walters

C. M. Bottorff
Administrative Trademark

Judges,

Trademark Trial and Appeal

Board